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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/722,619  | 11/26/2003  | Peter Davis          | 10480033040202      | 7100             |
| 37211   | 7590        | 09/15/2004           | EXAMINER            |                  |
| BASCH & NICKERSON LLP<br>1777 PENFIELD ROAD<br>PENFIELD, NY 14526 |             |                      | PURVIS, SUE A       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1734                |                  |
| DATE MAILED: 09/15/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,619

Applicant(s)

DAVIS ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-44 is/are allowed.
- 6) ☒ Claim(s) 32 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koda et al. (US Patent No. 5,984,176) in view of Uchimura et al. (US Patent No. 4,618,392), Schroeder et al. (US Patent No. 5,399,288), Franklin et al. (US Patent No. 5,540,795), and Slagter (US Patent No. 4,813,571).

Koda discloses it is known to adhere a label to an electronic component (See Figure 2). The label is applied to an electronic device such as a printed board (17) which electronic components (18) thereon, equivalent to applicant's printed circuit board. Koda fails to give details on how that label is applied. Figure 2, which is not discussed in detail in the specification, is a diagram showing the step of issuing a label in the manufacturing method, including a printer (11) and a roll of labels (12) with a liner.

When considering how the labeling step is to occur in Koda, it is within the purview of one having ordinary skill in the art to look to other labeling devices to see how labeling is typically done. Since the labels are fed from a roll in Koda as suggested by Figure 2, the label will need to be peeled from the label liner then placed on the board.

Uchimura discloses a method where a label is held on a roller platform (Figure 5) and picked up from there and placed onto the article to be labeled. The rollers holding the label

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are made of Teflon. (Col. 2, lines 31-35.) The labels are fed from a printer (1) but no details are given as to whether the label is held on a liner within the printer.

Schroeder demonstrates that it is known in the art to feed labels from a liner (19) onto a roller platform. Therefore, when a label is held on a liner, it is the step of advancing the liner over a separation edge which causes the label to be peeled.

As for the steps for controlling the label application process, it is within the purview of the artisan to look to a system such as the one in Franklin. Franklin discloses a method of applying labels which includes a detection sensor (95) which determines when a label (13) is at the pick up point. The sensor (95) communicates to the control means (93) to cause the transfer mechanism to pick up the label and transfer it to the article to be labeled. When the label (13) is picked up, the sensor (95) produces a signal which is used to start the label producing process so that a new label will be at the pick up point when it is time for the next article to be labeled. Using a sensor like this enables the system to have a faster cycle time. (Col. 10, lines 16-60.)

However, Franklin does not suggest how the label gets to the pick up point or detail that the label is held on a liner. For an instance where the label is fed from a liner, the movement of the liner over the peeler edge must be controlled to be timed with the label pick up mechanism otherwise there could be an instance where more than one label is placed on the pick up place. This type of control is known in the art. In particular, the advancement of the liner must be stopped so the label can be removed. This feature is discussed in Slagter where a sensor is used to sense the edge of the label and as a result stop the advancement of the liner. (See Abstract.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the features shown in Uchimura, Schroeder, Franklin, and Slagter in the method of applying a label introduced in Koda. It is known in the method of

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applying a label to include a roller platform as disclosed in Uchimura. Using a roller platform to hold a label is advantageous, because the label can be picked up easily from the platform. A non-stick roller platform prevents the label from sticking to the surface of the rollers and allows the label to be easily removed by the suction head which places the label onto the article to be labeled. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a control feature into the method of Koda in view of Uchimura to communicate when a label is in the pick up position, because such control schemes in labeling methods are well known in the art. This would prevent the suction head which applies the label to the object, such as a printed board, from trying to pick up something that is not there. Furthermore, Franklin uses pick and place control methods and in such methods either the timing of the label advancement must be perfect or the scheme must allow for the stopping and starting of the label supply, this is also shown in Slagter.

Applicant is reminded a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Response to Arguments***

3. Applicant's arguments filed 07 July 2004 have been fully considered but they are not persuasive and are in part moot because of the new grounds of rejection.
4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Allowable Subject Matter***

5. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 34-44 are allowed.

7. The following is an examiner's statement of reasons for allowance:

This statement of reasons for allowances replaces the statement made by the examiner in the Office Action dated 12 March 2004. The applicant was able to point out sufficient support in the parent application of 09/028,790, which has a filing date of 24 Feb 1998, for including a labeler in a surface mount assembly system. Thus, the Kuno (JP 11-11446) reference is not considered to be prior art based on the filing date of the parent application 09/028,790. The newly discovered reference Kou (US Patent No. 6,027,019) is not considered prior art because of the affidavit filed on 07 July 2003 under 37 CFR 1.131 in the other parent case (US Serial No. 09/550,030). Without the teachings in Kuno and Kou there is no reason or suggestion for incorporating a labeler into a pick and place machine for electronic components.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

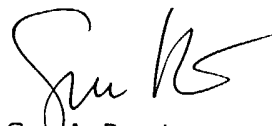
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**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
September 10, 2004